

REMARKS/ARGUMENTS

Claims 1-17 are pending in this application. Claims 1, 3, 8, 10, 16, 17, and 19 stand rejected and claims 2, 4-7, 9, and 11-15 are withdrawn from consideration. By this Amendment, claims 1 and 8 have been amended. The amendments made to claims 1 and 8 do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to claims 1 and 8 have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in condition for immediate allowance.

Claims 1, 3, 8, 10, and 18-19 stand rejected under 35 U.S.C. §103(a) as obvious over Sakai (JP 11-320989A).

To establish a *prima facie* case of obviousness, the prior art must teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, Sakai does not disclose or suggest the invention claimed by the Applicant.

Among the limitations of independent claim 1 not present in Sakai are:

the control unit activates the medium transport device in such a way that the medium transport device carries out a rest state transport at periodic intervals, and carries out the rest state transport at the start of an activation of the printer caused by receipt of a print job before processing the print job.

Independent claim 1 recites that the control unit activates the medium transport device in such a way that the medium transport device carries out a rest state transport at two different times, (1) first at a periodic interval and (2) second at the start of an activation of the printer caused by receipt of a print job before processing the print job.

In the Office Action, the Examiner finds that Sakai discloses carrying out a rest state transport periodically, as is recited in independent claim 1. Sakai only discloses the first condition recited in claim 1 and is silent with respect to any disclosure of the second condition recited in claim 1. The Examiner acknowledges that Sakai fails to teach the second condition, a rest state transport at the start of an activation of the printer caused by receipt of a print job before processing the print job, as is recited in independent claim 1 (see Office Action at p. 4, par. 4). Nevertheless, the Examiner states that since Sakai discloses performing the rest state transport periodically, it would be obvious to perform the rest state transport at the start of an activation of the printer caused by a print job to ensure the printing medium is not stuck.

The Examiner's above statement is conclusory. Under U.S. Patent Law, "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In this case, the above statement by the Examiner is not supported by any evidence, such as citation to the prior art, or by any of the rationales for supporting *prima facie* obviousness specified in the MPEP. Without any rational underpinning support, the above conclusory statement by the Examiner is an improper reliance on impermissible hindsight analysis.

The Examiner states that the conclusion of obviousness was not based on hindsight reasoning but knowledge available to one skilled in the art at the time the invention was made citing *In re McLaughlin*, 170 USPQ 209 (C.C.P.A. 1971). However, *In re McLaughlin* does not support the Examiner's position. In *McLaughlin*, the examiner cited several references that were combined and disclosed all of the limitations of the claims. The examiner in *McLaughlin* utilized prior art references to disclose each claim limitation.

In contrast, in the present case, the Examiner acknowledges that Sakai fails to specifically teach providing a rest state transport at the start of an activation of the printer caused by receipt of a print job, but such an operation would have been obvious. It is precisely this limitation, for which the Examiner has no reference, which makes claim 1 patentable over Sakai.

Without using impermissible hindsight reconstruction, if the Examiner insists on maintaining this rejection, the Examiner must provide a reference that teaches a control unit that “carries out the rest state transport at the start of an activation of the printer caused by receipt of a print job before processing the print job.” If, as the Examiner asserts, this feature would have been obvious to one skilled in the art, in view of *In re McLaughlin*, a reference should be cited to disclose this feature. If no reference can be cited, a *prima facie* case of obviousness has not been made and this rejection must be withdrawn.

Applicants further note that the solution provided by Sakai, namely the periodic performance of a rest state transport does not relate to cyclical movement at any desired time between printing operations and certainly is not performance of a rest state transport in response to receiving a print job. Sakai merely discloses a periodically performing a rest state transport. This periodic performance does not occur at any desired time but at predetermined intervals, the predetermined intervals being unrelated to receiving a print job.

In view of the above, the Examiner failed to establish a case of *prima facie* obviousness against independent claim 1. Therefore, the invention recited in independent claim 1 patentably distinguishes over the cited art.

Claim 3 depends from, and contains all the limitations of claim 1. This dependent claim also recite additional limitations which, in combination with the limitations of claim 1, are neither

disclosed nor suggested by Sakai and are also directed towards patentable subject matter. Thus, claim 3 should also be allowed.

Claims 8 and 16 are allowable for at least the same reasons as claims 1 and therefore, claims 8 and 16 and their dependent claims must be allowed.

Claims 16-17 and 20 stand rejected under 35 U.S.C. §103(a) as obvious over Burkart (US 6,437,815) in view of Sakai.

Burkart was not added to cure the deficiencies of Sakai but to show additional limitations, which, even if it was to show, does not cure the deficiencies discussed above. As such, Applicant respectfully submits that the claims are allowable over the cited references.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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